

REMARKS

This Amendment is submitted in response to the Office Action dated August 13, 2002. In the Office Action, the Patent Office objected to the specification as failing to provide proper antecedent basis for the claimed subject matter. Also in the Office Action, the Patent Office rejected Claims 1-4, 6-9, 14-17 and 19 under 35 U.S.C. §103(a) as being unpatentable over *Fischer* (U.S. Des. Patent No. 286,650) in view of *Martin et al.* (U.S. Patent No. 1,134,691). In addition, the Patent Office also rejected Claims 5, 11 and 18 under 35 U.S.C. §103(a) as being unpatentable over *Fischer* in view of *Martin et al.* and further in view of Applicant's disclosure.

By the present Amendment, Applicant amended Claims 1, 9, 15 and 17. Applicant submits that the amendments to the claims overcome the objection and rejections thereto as made by the Patent Office and places the application in condition for allowance.

In the Office Action, the Patent Office objected to the specification as failing to provide proper antecedent basis for the claimed subject matter. More specifically, the Patent Office objected to the use of the limitation "substantially covers" in independent Claims 1, 9, 15 and 17. Applicant amended Claims 1, 9, 15 and 17 to remove this limitation. Thus, the objection of the Patent Office is now moot.

In the Office Action, the Patent Office rejected Claims 1-4, 6-9, 14-17 and 19 under 35 U.S.C. §103(a) as being unpatentable over *Fischer* in view of *Martin et al.* This rejection is respectfully traversed in view of the claims as amended and for the reasons that follow.

Fischer is a design patent which discloses a sleeve for a writing

instrument. The Patent Office alleges that the stitching of the sleeve removably secures the sleeve around the barrel of the marking device and is effectively a "clamp".

Martin et al., the Patent Office alleges, discloses a marking device accessory kit having a marking device with a body defined between a first end and a second end and a tip capable of producing a mark on the first end. *Martin et al.* also allegedly provides an end cap removably attached on the second end of the marking device wherein the end cap is interchangeable between a plurality of marking devices. A chain allegedly extends from the end cap.

However, Applicant amended Claims 1, 9, 15 and 17 to define a marking device having a body, or barrel, and a sheath or flat article covering the marking device. The sheath or the flat article has features not disclosed by *Fischer* or *Martin et al.*, taken singly or in combination.

Namely, independent Claim 1 requires a sheath having a first layer and a second layer wherein the first layer has an adhesive to attach to the second layer. Independent Claim 9 requires a flat article placed around the barrel to cover the barrel of the marking device. Further, a band is required that secures around the flat article to hold the flat article on the barrel. Independent Claim 15 requires a sheath defined between a first end and a second end wherein the sheath covers the body of the marking device and forms a gap between the first end and the second end of the sheath leaving a portion of the body of the marking device not covered by the sheath. Finally, independent Claim 17 requires a sheath having an antimicrobial substance coated on the sheath. Applicant asserts that neither *Fischer* nor *Martin et al.*, taken singly or in combination, even remotely teach or suggest a sheath or flat article or band as

defined in independent Claims 1, 9, 15 and 17.

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In fact, *Martin et al.* merely disclose a marking device having an end cap attached to a flexible stem by a chain. *Martin et al.* do not disclose a sheath or flat article that covers the body of the marking device between the first end and the second end wherein the sheath or flat article demonstrates the features defined by independent Claims 1, 9, 15 and 17. In fact, no teaching or suggestion exists in *Martin et al.* for a sheath which substantially covers a marking device.


Still further, Applicant asserts that no motivation exists to combine the teaching of *Martin et al.* with *Fischer* to produce Applicant's invention.

It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. *In re Simon*, 461 F. 2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most, if not all, elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's marking device, method for using the same and accessory kit. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. *Interconnect Planning Corp. v. Feil*,

774 F. 2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).



With the analysis of the deficiencies of *Martin et al.* and *Fischer* in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to modify *Martin et al.* and/or *Fischer* in the manner suggested by the Patent Office in formulating the rejection under 35 U.S.C. §103. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103.

Applicant submits that, for the reasons provided above, the rejections of Claims 1-9, 11, 14-19 by the Patent Office under 35 U.S.C. §103(a) are overcome and should be withdrawn. Notice to that effect is requested.

Claims 2-8 depend from Claim 1; Claims 10-14 depend from Claim 9; Claim 16 depends from Claim 15; and Claims 19 and 20 depend from Claim 17. These claims are further believed allowable over the references of record for the same reasons set forth with respect to their parent claims since each sets forth additional novel elements of Applicant's novel marking device, accessory kit and method for using the same.

In view of the foregoing remarks and amendments, Applicant respectfully submits that all of the claims in the application are in allowable form and that the application is now in condition for allowance. Further, Applicant submits that neither further search nor consideration would be necessitated by entry of this Amendment. Therefore, entry of this Amendment is proper and should be effected.

If, however, any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue. Applicant

requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,

(Reg. No. 35,018)

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CERTIFICATE OF MAILING

I hereby certify that this **Amendment** is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to the Asst. Commissioner for Patents, Box AF, Washington, D.C. 20231 on _____ 2003.

Brian M. Mattson

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Claim 1, as amended, follows:

1. (Amended) A marking device comprising:

a barrel having a body defined between a first end and a second end wherein the first end has a tip capable of producing a mark;

a sheath that [substantially] covers the body of the barrel between the first end and the second end wherein the sheath has a first layer and a second layer wherein the first layer has an adhesive to attach to the second layer; and

an end cap removably attached on the second end of the barrel wherein the end cap has a connecting lead extending from the end cap.

Claim 9, as amended, follows:

9. (Amended) A marking device accessory kit, the accessory kit comprising:

a marking device having a barrel defined between a first end and a second end wherein the first end has a tip capable of producing a mark;

a flat article placed around the barrel to cover [wherein the article substantially covers] the barrel of the marking device [between the first end and the second end];

[a clamp wherein the clamp removably secures the flat article around the barrel of the marking device] a band secured around the flat article to hold the flat article on the barrel; and

a cap having a lead extending from the cap wherein the cap is removably attached to the barrel at the second end.

Claim 15, as amended, follows:

15. (Amended) A marking device accessory kit, the accessory kit

comprising:

a marking device having a body defined between a first end and a second end wherein the first end has a tip capable of producing a mark;

a sheath defined between a first end and a second end wherein the sheath [that substantially] covers the body of the marking device [barrel between the first end and the second end] and forms a gap between the first end and the second end of the sheath leaving a portion of the body of the marking device not covered by the sheath;

an end cap removably attached on the second end of the marking device wherein the end cap is interchangeable between a plurality of marking devices; and

a connecting lead having a first end and a second end wherein the first end of the connecting lead extends from the end cap and is removably connected to the end cap.

Claim 17, as amended, follows:

17. (Amended) A method of using a marking device, the method comprising the steps of:

providing a barrel having a body defined between a first end and a second end wherein the first end has a tip capable of producing a mark;

providing a sheath that [substantially] covers the barrel between the first end and the second end wherein the sheath is coated with an antimicrobial substance;

providing an end cap for fitting over the second end of the barrel wherein the end cap has a connecting lead that extends from the end cap;

fitting the sheath over the barrel between the first end and the

second end; and

fitting the end cap over the second end of the barrel.